

## **REMARKS/ARGUMENTS**

### **Status of the Claims**

Applicants propose to cancel claims 4, 5, 12, 13, 20, 21, 27, 28, 33, 34, 39, and 40, without prejudice or disclaimer, and amend claims 1, 10, 14, 17, 26, 29, 32, 35, and 38. Applicants propose to amend independent claims 1, 10, 17, 26, 32, and 38 to incorporate the subject matter recited in claims 4 and 5, 12 and 13, 20 and 21, 27 and 28, 33 and 34, and 39 and 40, respectively. No new matter will be introduced by this amendment. Claims 1-3, 6-11, 14-19, 22-26, 29-32, 35-38, and 41-45 are currently pending in the application.

### **Claim Rejections Under 35 USC § 103**

Claims 1-45 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Carpentier et al. (U.S. Patent Pub. No. 2005/0283613; hereinafter, "Carpentier") in view of Keillor et al. (USPN 5,917,433; hereinafter, "Keillor"). Applicants respectfully traverse the rejections.

For a proper rejection under section 103(a), the Examiner must clearly articulate the reasons why the claimed invention would have been obvious. *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007). Where the prior art fails to disclose each and every element of a claim, the Examiner must explain why the differences between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art. M.P.E.P. § 2141(III), p. 2100-118 (Rev. 6, Sept. 2007). This explanation must include a clear basis for concluding that it would have been obvious to one of ordinary skill in the art to bridge the gap between the prior art and claimed invention. *Id.* The rejection cannot be based merely on conclusory statements. *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396.

In this case, Carpentier in view of Keillor fails to teach or suggest each and every element of the claims. Moreover, the Examiner has failed to provide a clear basis as to why it would have been obvious to bridge the gap between the claims and the cited references, including Carpentier and Keillor. Furthermore, the differences between the claims and the cited references are such that the claims are non-obvious in view of the cited references:

Claims 1 and 17 recite an apparatus for making an asset apparent to an individual that includes, *inter alia*, a receiver for receiving a request [wirelessly] for having the asset make itself apparent and providing the request to a processor, wherein the asset comprises equipment; the processor for receiving the request, wherein the processor generates a list of available apparency actions in response to receiving the request; and the processor for receiving [a] second request

[that comprises] a selected apparency action from the list of available apparency actions and for generating a command to make the asset apparent based on the selected apparency action.

Claim 10 recites a wireless communication device for making an asset apparent to an individual that includes, *inter alia*, an input for allowing the individual to enter an identification code corresponding to the asset, wherein the asset comprises equipment; an output for providing a list of available apparency actions that the asset is able to perform to the individual, wherein the input further allows the individual to select one of the available apparency options; and a processor for receiving the input and generating a request to make the asset apparent based on the selected one of available apparency actions.

Claims 26 and 32 recite signal-bearing medium tangibly embodying a program of machine-readable instructions executable by a digital processing apparatus to perform a method for making an asset apparent, said method comprising operations that include, *inter alia*, receiving an identification code corresponding to said asset, wherein the asset comprises equipment; providing a list of available apparency actions that the asset is able to perform to an individual; receiving a selected apparency action from the individual, the selected apparency action chosen from the list of available apparency actions; and generating a request to make said asset apparent, the request including the selected apparency method.

Claim 38 recites signal-bearing medium tangibly embodying a program of machine-readable instructions executable by a digital processing apparatus to perform a method for making an asset apparent, said method comprising operations that include, *inter alia*, receiving a request from a wireless communication system for having the asset make itself apparent, wherein the asset comprises equipment; generating a list of available apparency actions in response to receiving the request; receiving a second request for making the asset apparent, the second request comprising a selected apparency action from the list of available apparency actions; and generating a command to make the asset apparent, the command comprising the selected apparency action.

As Applicants noted in the July 16, 2008 Amendment, Applicants' claimed invention is directed to locating and making apparent physical assets. For example, as described in Applicants' Specification, assets "may include, for example, earth moving equipment, tractor trailers, construction equipment, railroad train cars and engines, cargo containers, and rental equipment of all shapes and sizes. Asset management is particularly important in instances

where assets are moved in the typical course of business or in cases where assets themselves are mobile” (Specification, ¶ [1002]). Further, “asset 106 makes itself apparent to the individual by performing one or more actions, such as by illuminating one or more lights connected to asset 106, by sounding an audible alert, or by moving a mechanical portion, or all of, asset 106” (Specification, ¶ [1018]). Therefore, as Applicants contended in the July 16 Amendment, Carpentier’s description of content addressable data on a network is not relevant to the tracking of and making apparent a physical asset that comprises equipment.

In particular, Carpentier discloses a system for facilitating access to content-addressable data on a network, which includes digital information storing devices that monitor broadcast data request and in return broadcast requested data over the network (Carpentier, Abstract; ¶ [003]). Carpentier specifically teaches that the data, which may be any binary sequence, is referred to as digital asset or simply asset (¶ [011]). Digital assets can be identified using a content-based identifier, collected using a file collector, and stored in a file storage (FIG. 3; ¶¶ [030], [049], and [050]). However, contrary to the Examiner’s allegation that the file collector and storage read on “the asset comprises equipment” (Office Action, p. 2, ll. 17-20; p. 4, ll. 7-10), Carpentier’s digital assets do not comprise the file collector or storage.

Moreover, Carpentier discloses that its data access system is enabled to accept a digital asset, which refer to binary sequences, and return a digital asset in a binary form to its human, application, or network device users (¶ [011]). In other words, Carpentier’s data access system digitally receives and provides digital assets in binary form, but does not teach providing a list of available actions for making the digital assets themselves apparent. Therefore, Carpentier fails to teach or suggest at least receiving a request [wirelessly] for having [an] asset make itself apparent, wherein the asset comprises equipment; and generating a list of available apparency actions in response to receiving the request, as recited in claim 38 and similarly recited in claims 1 and 17. Similarly, Carpentier fails to teach or suggest at least receiving an identification code corresponding to [an] asset, wherein the asset comprises equipment; providing a list of available apparency actions that the asset is able to perform to an individual; receiving a selected apparency action from the individual, the selected apparency action chosen from the list of available apparency actions; and generating a request to make said asset apparent, the request including the selected apparency method, as recited in claim 32 and similarly recited in claims 10 and 26.

Instead, the Examiner alleged that Keillor cures the deficiencies of Carpentier with respect to the claims and that it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify Carpentier based on the teachings of Keillor (Office Action, p. 3, ll. 9-18). Applicants respectfully disagree.

Specifically, Keillor discloses monitoring systems for monitoring the position and/or status of a container, which includes open or enclosed trailers, rail cars, shipping containers, etc. (Keillor, Abstract; FIG. 1). Keillor collectively refers to the container and its contents as an asset (col. 1, ll. 5-13). Keillor teaches that the asset monitoring systems include position determining means for determining the container's position (FIGS. 3 and 4; col. 8, ll. 3-18), and various sensors for monitoring the container's status, such as temperature sensors and door position sensors (col. 7, ll. 1-17). Keillor, however, fails to teach or suggest at least generating a list of available apparency actions in response to receiving [a] request [for having an asset make itself apparent], as recited in claim 38 and similarly recited in claims 1 and 17. Likewise, Keillor fails to teach or suggest at least receiving an identification code corresponding to [an] asset, wherein the asset comprises equipment; providing a list of available apparency actions that the asset is able to perform to an individual; receiving a selected apparency action from the individual, the selected apparency action chosen from the list of available apparency actions; and generating a request to make said asset apparent, the request including the selected apparency method, as recited in claim 32 and similarly recited in claims 10 and 26.

Therefore, Carpentier and Keillor, taken alone or in combination, fail to disclose, teach, or suggest each and every element recited in claims 1, 10, 17, 26, 32, and 38. Furthermore, the Examiner has failed to provide a clear basis as to why the differences between the cited references and claims 1, 10, 17, 26, 32, and 38 would have been obvious. The Examiner merely alleged that that one of ordinary skill in the art would use "a receiver for receiving a request... for having the asset make itself apparent and providing the request to a processor, as taught by Keillor, in order to provide an asset monitoring system and associated method for tracking a container so as to identify the location of the container even after the container has been electrically untethered from an external power source" (Office Action, p. 3, ll. 12-18). Applicants respectfully disagree.

The Examiner's reasoning provides no basis why it would have been obvious to modify the system disclosed in Carpentier based on the teachings of Keillor to include at least generating

a list of available apparency actions in response to receiving [a] request [for having the asset make itself apparent]; receiving a second request for making the asset apparent, the second request comprising a selected apparency action from the list of available apparency actions; and generating a command to make the asset apparent, the command comprising the selected apparency action, as recited in claim 38 and similarly recited in claims 1 and 17. Similarly, the Examiner's reasoning provides no basis why it would have been obvious to modify the system disclosed in Carpentier based on the teachings of Keillor to include at least receiving an identification code corresponding to [an] asset, wherein the asset comprises equipment; providing a list of available apparency actions that the asset is able to perform to an individual; receiving a selected apparency action from the individual, the selected apparency action chosen from the list of available apparency actions; and generating a request to make said asset apparent, the request including the selected apparency method, as recited in claim 32 and similarly recited in claims 10 and 26.

Moreover, Carpentier discloses a system that includes digital information storing devices that monitor broadcast data request and in return broadcast requested data over the network, and specifically teaches that the data is any binary sequence (Carpentier, ¶¶ [003] and [011]). In contrast, Keillor discloses monitoring systems for monitoring the position and/or status of physical containers such as trailers, rail cars, shipping containers, etc. (Keillor, Abstract; FIG. 1). Therefore, Carpentier's digital data access system is not in the same field of endeavor as Keillor's container monitoring systems, contrary to the Examiner's allegations (Office Action, p. 3, ll. 9-11; p. 4, ll. 17-18). Furthermore, the differences between Carpentier and Keillor, even if properly combinable, and the claims are so great that the elements of claims 1, 10, 17, 26, 32, and 38 are non-obvious in view of Carpentier and Keillor.

For at least the foregoing reasons, Applicants submit that Carpentier and Keillor cannot be properly combined with respect to the claims, and that even if, assuming *arguendo*, that they can be properly combined, Carpentier in view of Keillor fails to teach or suggest the subject matter recited in claims 1, 10, 17, 26, 32, and 38. Accordingly, Applicants submit that claims 1, 10, 17, 26, 32, and 38 are in condition for allowance, as are claims 2, 3, and 6-9, claims 11 and 14-16, claims 18, 19, and 22-25, claims 29-31, claims 35-37, and claims 41-45 at least by virtue of their respective dependencies from allowable claims 1, 10, 17, 26, 32, and 38. Therefore,

Applicants respectfully request that the Examiner reconsider and withdraw the § 103(a) rejection of claims 1-3, 6-11, 14-19, 22-26, 29-32, 35-38, and 41-45.

**CONCLUSION**

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1-3, 6-11, 14-19, 22-26, 29-32, 35-38, and 41-45 in condition for allowance. Applicants submit that the proposed cancellation of claims 4, 5, 12, 13, 20, 21, 27, 28, 33, 34, 39, and 40 and amendment of claims 1, 10, 14, 17, 26, 29, 32, 35, and 38 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, because all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicants respectfully point out that the final action by the Examiner presented some new arguments as to the application of the art against Applicants' invention. It is respectfully submitted that the entering of the Amendment would allow the Applicants to reply to the final rejections and place the application in condition for allowance.

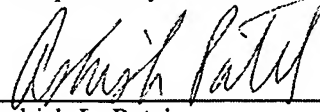
Applicants further submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In light of the amendments contained herein, Applicants submit that the application is in condition for allowance, for which early action is requested.

Please charge any fees or overpayments that may be due with this response to Deposit Account No. 17-0026.

Respectfully submitted,

Dated: December 29, 2008

By:   
Ashish L. Patel  
Reg. No. 53,440  
(858) 658-2585

QUALCOMM Incorporated  
Attn: Patent Department  
5775 Morehouse Drive  
San Diego, California 92121  
Telephone: (858) 658-2585  
Facsimile: (858) 658-2502